

### **REMARKS**

The Office Action mailed February 15, 2011 has been received and reviewed. Applicant expresses appreciation for the interview courteously granted April 4, 2011. Claims 105-143 are in the case. Claims 105-143 stand rejected under 35 U.S.C. § 103(a).

By this paper, claims 105, 106, 107, 114, 124, 129, 136, 137, and 141 have been amended. Claim 125 is canceled. For the reasons set forth below, claims 105-124, and 126-143 are believed to be in condition for immediate allowance. Favorable reconsideration of the application in view of the following remarks is, therefore, respectfully requested.

### **Statement of Substance of Interview**

Applicant's counsel met with the examiner on April 4, 2011 to discuss the independent claims. Although Applicant respectfully asserts that the combination of Streich and Blohm fails to provide all the recited elements of Applicant's independent claims, and that the combination is improper, clarifications were deemed appropriate. It is Applicant's understanding that clarifying the operation of the second computer over the network, where recited, was requested. Also, clarifying the monolithic nature of the label with its advertising images on the computer readable medium was understood by Applicant to distinguish over the art. Likewise, it was understood by Applicant that reciting two, rather than just one images or identifiers of the various types disclosed in the specification would distinguish over the art. Accordingly, Applicant has made those changes by this Amendment, in accordance with Applicant's understanding, but makes no representation that agreement was reached with the examiner. That is the examiner's decision to make and to represent as the examiner sees fit.

### **Rejection of Claims 105-143 Under 35 U.S.C. §103(a)**

Claims 105-143 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Streich (U.S. Patent No. 3,314,592) in view of Blohm (U.S. Patent No. 5,881,538). Applicant has amended as per the interview, in order to move the case toward allowance, but also respectfully traverses the rejection on the record, nevertheless.

To establish a *prima facie* case of obviousness, the Office action must find all the elements of each claim rejected and then provide clear articulation of the reason(s) why the claimed invention would have been obvious. *See* MPEP 2143. The combination of Streich and Blohm does not meet this test. Streich teaches a mailer (Col. 4, lines 5-15), and an advertising message inside (Col. 3, Lines 32-37) unlike Applicant's point of purchase advertising impression on a product label. Blohm has an included CD that is not seen at the point of purchase, and could not be if it is to be protected by the magazine around it (See, *e.g.*, Col. 1, lines 47-61, Col 2, line 23, Col. 4, lines 44-52).

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the combination could have been made by one of ordinary skill in the art, and the results would have been predictable to one of ordinary skill in the art. MPEP §2143.01(III); *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_, \_\_\_, 82 USPQ2d 1385, 1396 (2007). Here, Streich shows various versions of a mailer (Col. 4, Lines 5-15) attachable to packages of various shapes (Col. 3, lines 52-56). Such a teaching would not combine with Blohm's packaging of a CD. Streich's device is required to be adaptable to various shapes, including the preferred embodiment wrapped around a cylindrical container (Col. 3, lines 52-56). Streich teaches against mailing and in favor of protection for a CD, mentioned repeatedly. (See Col. 2, Line 23; Col. 4, Lines 16-24; Col. 4, Lines 44-52.)

A statement that modifications of the prior art to meet the claimed invention would have been well within the ordinary skill of the art at the time the claimed invention was made because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. MPEP §2143.01(IV); *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). Here, the fact that certain features may be of mutual benefit is improper where those features cannot be combined as discussed above.

Moreover, if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. MPEP §2143.01(VI); *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Here, the modification of either reference to combine with the other, violates the operating principles of each, the wrap around mailer with advertising inside compared to the

protected computer CD, as discussed above. If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims prima facie obvious. MPEP §2143.01(VI); *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

A prior art reference that “teaches away” from the claimed invention is a significant factor to be considered in determining obviousness. MPEP §2145(X)(D)(1); *In re Gurley*, 27 F.3d 551, 554, 31 USPQ2d 1130, 1132 (Fed. Cir. 1994). Moreover, it is improper to combine references where the references teach away from their combination. MPEP §2145(X)(D)(2); *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983).

Nevertheless, Applicant has made the amendments suggested by the examiner in the interview, as best understood, in order to move the case to allowance. It is Applicant’s understanding that each of the amendments (regarding the second computer, monolithic label with computer readable medium, and the various entities identified on the label, may be patentably distinct, standing alone, but all are implemented as appropriate in the amendments herein.

Support for multiple items of information on the label are found in the specification at Page 2, line2 (supplier); Page 3, lines13-17 (slogan, message, trademark, image, logo, vendor, manufacturer); Page 12, lines 3-19 (product, vendor, slogan, trademark, identification, messages, content, other marks on face); Page 34, lines 1-9 (product, brand, vendor, other name, logos, images, symbols, trademarks, pictures, facts, source of product, on outer surface); Page 42, line 10 (words, printed); Page 42, line 1(manufacturer), and so forth.

In the event that the examiner finds any remaining impediment to the prompt allowance of any of these claims, which could be clarified in a telephone conference, the examiner is respectfully urged to initiate the same with the undersigned.

DATED this 13<sup>th</sup> day of April, 2011.

Respectfully submitted,

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